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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 10013861-1
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on <u>1/17/07</u></p> <p>Signature <u>Julie A. Symons</u></p> <p>Typed or printed name <u>Desiree Reardon</u></p>		Application Number 09/971,857 Filed 10/04/01 First Named Inventor Julie A. SYMONS Art Unit 2151 Examiner Divecha, K. B.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- applicant/inventor.
- assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- attorney or agent of record. 35,398
Registration number _____
- attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____


Signature
John P. Wagner Jr.

Typed or printed name

408-938-9060

Telephone number

1/17/07
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

<input type="checkbox"/>	*Total of _____ forms are submitted.
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Remarks Accompanying Pre-Appeal Brief Request For Review

In response to the final Office Action dated October 17, 2006, Applicant respectfully requests a review of the final rejection in the above-identified application. Applicant respectfully submits that the Examiner's rejections of the Specification under 35 U.S.C. § 112, first paragraph, as being non-enabling is improper as the Specification is, in fact, enabling. Applicant respectfully submits that the Examiner's rejections of Claims 1-27 are rejected under 35 U.S.C. § 112, first paragraph, as being related to a non-enabling disclosure is improper as the disclosure is, in fact, enabling. Applicant respectfully submits that the Examiner's rejections of Claims 1-5 and 8-9 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Arkko et al., (U.S. Patent 6,535,517), hereinafter referred to as "Arkko" in view of Fitzgerald et al. (5581764), hereinafter referred to as "Fitzgerald" is improper as the references are not sufficient to render the claims *prima facie* obvious. Furthermore, Applicant respectfully submits that the Examiner's rejections of Claims 10-16, 18, 19-25 and 27 are rejected under 35 U.S.C. § 103 (a) as being obvious over Arkko in view of Aoyagi et al. (2002/0032761A1) hereinafter referred to as "Aoyagi, and in further view of Ootani et al., (2002/0135610), hereinafter referred to as "Ootani" is also improper as the references are not sufficient to render the claims *prima facie* obvious.

Objection to the Specification under 35 U.S.C. §112, first paragraph.

At page 4, the Office Action objected to the Specification under 35 U.S.C. § 112, first paragraph, as being non-enabling. Specifically, the rejection states "the claim recites "... storing an expected network infrastructure description of a network having a switched infrastructure without requiring hubs..." However, the disclosure merely describes storing an expected network infrastructure network description (see Specification, page 9 lines 11-25). Therefore, the above limitation presents the subject matter that was not described in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the Claimed invention."

Applicant has reviewed the rejection and respectfully submits that the objected is improper as the Specification is, in fact, enabling for the following rationale. Applicant respectfully states that contained within the present Specification the claimed feature "... storing an expected network infrastructure description of a network having a switched infrastructure without requiring hubs..." is described in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the Claimed invention.

Specifically, on page 8 lines 16-26 of the present Specification states “FIG. 2 represents a network having a data center where central control over the network can be maintained. In one embodiment, the physical environment 250 relies upon a switched network environment. In a switched network, the hubs used to couple devices in the network are replaced with switches. Unlike hubs which share network segments, switches provide a segment for each device connected to it. By replacing the hubs with switches, devices connected to the network can be physically isolated and/or located by the data center operators because there is a one-to-one mapping between a given device and the switch port to which it is connected” (emphasis added).

Therefore, Applicant respectfully submits that the Specification is enabling and as such the objection to the Specification under 35 U.S.C. § 112, first paragraph, as being non-enabling is incorrect and should be withdrawn.

Claims 1-27 are rejected under 35 U.S.C. §112, first paragraph, for the same reason as set forth in objected Specification above.

At page 5, the Office Action states that Claims 1-27 are rejected under 35 U.S.C. §112, first paragraph, for the same reason as set forth in objected Specification above

For the same reasons provided above as to why the objection to the Specification under 35 U.S.C. § 112, first paragraph, as being non-enabling is incorrect and should be withdrawn, Applicant respectfully submits that the rejection of Claims 1-27 under 35 U.S.C. § 112, first paragraph, is also incorrect and should be withdrawn.

Claims 1-5 and 8-9 under 35 U.S.C. § 103 (a) as being unpatentable over Arkko in view of Fitzgerald.

At page 6, the Office Action rejected Claims 1-5 and 8-9 under 35 U.S.C. § 103 (a) as being unpatentable over Arkko in view of Fitzgerald. Applicant respectfully submits the rejection is improper as the references are not sufficient to render the claims *prima facie* obvious.

Applicant has reviewed the cited references and respectfully submits that the embodiments of the present invention as recited in Claims 1-5 and 8-9 are not

unpatentable over unpatentable over Arkko in view of Fitzgerald for the following rationale.

Applicant respectfully submits that Independent Claim 1 recites the features “A method for managing a switched network infrastructure comprising:

storing an expected network infrastructure description of a network having a switched infrastructure without requiring hubs, said network having a data center...” (emphasis added).

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (MPEP 2143.03).

On page 6 of the present Office Action, the Examiner states that Arkko discloses the feature storing an expected network infrastructure description of a network having a switched infrastructure, said network having a data center. However, the Examiner does not show, and Applicant does not understand, Arkko to teach or suggest the claimed feature storing an expected network infrastructure description of a network having a switched infrastructure without requiring hubs, said network having a data center (emphasis added).

In other words, the rejection of Claims 1-5 and 8-9 does not provide any teaching or suggestion of the claimed features “storing an expected network infrastructure description of a network having a switched infrastructure without requiring hubs” (emphasis added). Moreover, the Examiner does not rely on any other references, e.g., Aoyagi, to teach or suggest the claimed features. As such, *prima facie* obviousness is not established. Therefore, the rejection under 35 U.S.C. § 103 (a) is improper as the references are not sufficient to render the claims *prima facie* obvious.

For this reason, Applicant respectfully submits that Arkko in view of Aoyagi does not teach or render obvious the features of Independent Claim 1 and as such Claim 1 is improperly rejected and is, in fact, in condition for allowance. Moreover, Claims 2-5 and 8-9 are dependent on Claim 1 and recite further features of the Claimed invention. In addition, Claims 6 and 7 are also dependent on Independent Claim 1 and, as such, are also in condition for allowance.

Further detail of the incompatibility and shortcomings of the combination of Arkko in view of Aoyagi can be found on pages 8-10 of the response to the Office Action mailed 4/25/2006.

Claims 10-16, 18, 19-25 and 27 are rejected under 35 U.S.C. § 103 (a) as being obvious over Arkko in view of Aoyagi and in further view of Ootani.

Claims 10-16, 18, 19-25 and 27 are rejected under 35 U.S.C. § 103 (a) as being obvious over Arkko in view of Aoyagi and in further view of Ootani.

Claim 19 (and similarly Claim 10) includes the feature “storing an expected network infrastructure description as an XML data type description of a network having a switched infrastructure without requiring hubs, said network having a data center” (emphasis added).

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (MPEP 2143.03).

On page 12 of the present Office Action, the Examiner states that Arkko discloses the feature storing an expected network infrastructure description of a network having a switched infrastructure, said network having a data center. However, the Examiner does not show, and Applicant does not understand, Arkko to teach or suggest the claimed feature storing an expected network infrastructure description of a network having a switched infrastructure without requiring hubs, said network having a data center (emphasis added).

In other words, the rejection of Claims 10-16, 18, 19-25 and 27 does not provide any teaching or suggestion of the claimed features “storing an expected network infrastructure description of a network having a switched infrastructure without requiring hubs” (emphasis added). Moreover, the Examiner does not rely on any other references, e.g., Aoyagi and Ootani, to teach or suggest the claimed features. As such, *prima facie* obviousness is not established. Therefore, the rejection of Claims 10-16, 18, 19-25 and 27 under 35 U.S.C. § 103 (a) is improper as the references are not sufficient to render the claims *prima facie* obvious.

For this reason, Applicant respectfully submits that Arkko in view of Aoyagi and further in view of Ootani does not teach or render obvious the features of Independent Claims 10 and 19 and as such Claims 10 and 19 are improperly rejected and are, in fact, in condition for allowance. Moreover, Claims 1-16, 18, 20-25 and 27 are dependent on Claims 10 and 19 and recite further features of the Claimed invention.

Further detail of the incompatibility and shortcomings of the combination of Arkko in view of Aoyagi can be found on pages 10-14 of the response to the Office Action mailed 4/25/2006.